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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

CHOJNACKI, MELLISSA M

ART UNIT PAPER NUMBER

2164

DATE MAILED: 10/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/645,123

Applicant(s)

DETTINGER ET AL.

Examiner

Mellissa M. Chojnacki

Art Unit

2164

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 July 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7, 18-21 and 30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 18-21 and 30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.



SAM RIMELL
PRIMARY EXAMINER

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 8/23/02 & 10/24/05.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Remarks

1. In response to communications filed on July 10, 2006, applicant has elected Group I claims 1-7 and 18-21 and added new claim 30. Therefore, claims 1-7, 18-21, and 30 are presently pending in the application.

Specification

The specification is object to because:

2. The abstract contains the phrases "such as", "are provided", "As an example", "should take", "For some embodiments" and "may also be suggested". The abstract should not contain "such as", "provided", "example" and "embodiments". "Should take" and "may also be suggested" are vague and indefinite and should also not be contained within the "Abstract". Correction is required.

3. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Drawings

4. The drawings are objected to because in figures 2-3 disclose element with subscripted numbers which is not standard format and makes it difficult to understand. Specifically, Fig. 2, element 214 and Fig. 3 elements 208, 210 and 212. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 1-7 and 30 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1 and 30 are not limited to a method that runs on a medium. As such, the claim is not limited to statutory subject matter and is therefore non-statutory. The claims lack the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 USC 101. They are clearly not a series of steps or acts to be a process nor are they a combination of chemical compounds to be a composition of matter. As such, they fail to fall within a statutory category. They are, at best, functional descriptive material *per se*.

Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." Both types of "descriptive material" are

nonstatutory when claimed as descriptive material *per se*, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994)

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-7, 18-21 and 30, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1, 18 and 30 discloses a "receiving an indication", which renders the claim vague and indefinite, because it is unclear as to what a "indication", signifies in the claim.

Claim 1, 18, and 30 recites the limitation "a selected query component". There is insufficient antecedent basis for these limitations in the claim because there was some selection made pertaining to the query however it is not indicated in the claim language.

Claim 1, 18, and 30 discloses a "component" and "create an annotation", which renders the claim vague and indefinite, because it is unclear as to what a "component"

and "annotation", signifies in the claim. They are both very vague and need to be clarified within the claim.

Claim 1 discloses "capturing information", which renders the claim vague and indefinite, because it is unclear as to what "capturing", signifies in the claim.

Claims 2-7, and 19-21 are rejected under 35 U.S.C. 112, second paragraph, because they are dependent upon rejected independent claims 1 and 18.

Claim 3 discloses "instance value", which renders the claim vague and indefinite, because it is unclear as to what "instance value" is and signifies in the claim.

Claim 5 discloses "suggested substitution", which renders the claim vague and indefinite, because it is unclear as to what "substitution", signifies in the claim.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1-7, 18-21 and 30 are rejected under 35 U.S.C. 102(e) as being anticipated by Bays et al. U.S. Patent No. 6,519,603.

As to claim 1, Bays et al. teaches a method of capturing information useful in the building of queries (See abstract; column 2, lines 10-15; column 3, lines 5-11),

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comprising: receiving an indication of a selected query component (See column 5, lines 1-21); providing an interface allowing a user to create an annotation to associate with the selected query component (See column 6, lines 35-39); and storing the annotation with a reference to the selected query component (See column 9, lines 50-65; column 11, lines 8-15).

As to claim 2, Bays et al. teaches wherein the query component comprises one or more query conditions (See abstract; column 2, lines 10-29).

As to claim 3, Bays et al. teaches wherein the query component comprises one or more instance values of data (See column 2, lines 61-67; column 9, lines 50-65).

As to claim 4, Bays et al. teaches providing an interface for building a query by specifying query components (See abstract; column 2, lines 10-15; column 3, lines 5-11); and wherein receiving an indication of the selected query component comprises receiving a user selection of one or more query components specified, via the interface, for use in a query (See abstract; column 2, lines 10-15; column 3, lines 5-11).

As to claims 5 and 19, Bays et al. teaches providing an interface allowing the user to create a suggested substitution for the selected query component (See column 9, lines 50-65; column 11, lines 8-15); wherein the operations further comprise providing an interface allowing the user to create a suggested substitution for the selected query

component (See column 9, lines 50-65; column 11, lines 8-15).

As to claim 6, Bays et al. teaches wherein storing the annotation with a reference to the one or more query components comprises: decomposing the query component into one or more fragments; and storing the fragments with the annotation (See column 9, lines 50-65; column 11, lines 8-15).

As to claims 7 and 20, Bays et al. teaches wherein storing the annotation with a reference to the one or more query components comprises: substituting a parameter marker for an instance value contained in the query component; and storing the query component with the parameter marker with the annotation (See column 9, lines 50-65; column 11, lines 8-15); wherein storing the annotation with a reference to the one or more query components comprises: substituting a parameter marker for an instance value contained in the query component; and storing the query component with the parameter marker with the annotation (See column 9, lines 50-65; column 11, lines 8-15).

As to claim 18, Bays et al. teaches a computer-readable medium containing a program for annotating query components which, when executed by a processor (See abstract; column 2, lines 10-15; column 3, lines 5-11; column 6, lines 20-28), performs operations comprising: receiving an indication of one or more selected query component (See column 5, lines 1-21); providing an interface allowing a user to create

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an annotation to associate with the selected query component (See column 6, lines 35-39); and storing the annotation with a reference to the selected query component (See column 9, lines 50-65; column 11, lines 8-15).

As to claim 21, Bays et al. teaches wherein the operations further comprise: monitoring one or more query components specified for use in a query (See abstract; column 2, lines 10-15; column 3, lines 5-11); searching for annotations associated with the one or more query components (See column 11, lines 16-24); and providing an indication of one or more annotations, if found, associated with the one or more query components (See column 5, lines 1-21).

As to claim 30, Bays et al. a method (See abstract), comprising: receiving an indication of a selected query component (See column 5, lines 1-21); providing an interface allowing a user to create an annotation to associate with the selected query component (See column 6, lines 35-39); storing the annotation with a reference to the selected query component (See column 9, lines 50-65; column 11, lines 8-15); monitoring one or more query components specified for use in a query being composed in a query building interface (See abstract; column 2, lines 10-15; column 3, lines 5-11); searching for stored annotations associated with the one or more query components (See column 11, lines 16-24); and providing an indication of one or more annotations, if found, associated with the one or more query components (See column 5, lines 1-21).

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mellissa M. Chojnacki whose telephone number is (571) 272-4076. The examiner can normally be reached on 9:00am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Rones can be reached on (571) 272-4085. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

September 22, 2006
Mmc


SAM RIMELL
PRIMARY EXAMINER